

## **REMARKS**

### **35 U.S.C. §101 rejections**

In the March 5, 2009 Office Action claims 25 – 32 and 49 - 62 are rejected under 35 U.S.C. §101 as representing non statutory subject matter. The Assignee traverses the rejections for non statutory subject matter in a number of ways. First, by noting that the claim rejections are not in compliance with the Administrative Procedures Act and are therefore moot. Second, by noting that there is no statutory basis for the claim rejections. Third, by noting that the Office Action has failed to establish a prima facie case of non statutory subject matter. It is well established that the burden is on the USPTO to set forth a prima facie case of unpatentability In (see *in re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In spite of this well known requirement, the March 5, 2009 Office Action contained only conclusory statements that the rejected claims represented non-statutory subject matter. In short, the complete absence of evidence leads to the inevitable conclusion that the Examiner has failed to establish a prima facie case that would support a §101 rejection for a single claim. Fourth, the Assignee notes that claim amendments have obviated the claim rejections.

### **35 U.S.C. §112 first paragraph rejections**

In the March 5, 2009 Office Action claim 62 is rejected under 35 U.S.C. §112 first paragraph. In particular, the Examiner feels that the term "intelligent agent" has not been adequately explained. The Assignee traverses the rejections for written description in a number of ways. First, by noting that the claim rejections are not in compliance with the Administrative Procedures Act and are therefore moot. Second, by noting that there is no statutory basis for the claim rejections. Third, by noting that is well known to those of average skill in the art that the term intelligent agent is used interchangeably with the term bot. Furthermore, the definition of bot used in the specification corresponds to a widely accepted definition of the term "intelligent agent".

### **35 U.S.C. § 112 Second Paragraph Rejection of Claims**

In the March 5, 2009 Office Action claims 25 – 32 and 49 - 62 are rejected under 35 U.S.C. §112 second paragraph. In particular, the Examiner feels that the meaning of several terms are unclear. The Assignee traverses the rejections for indefiniteness in a number of ways. First, by noting that the claim rejections are not in compliance with the Administrative Procedures Act and are therefore moot. Second, by noting that there is no statutory basis for the claim rejections. Third, by noting that the Office Action has failed to establish a prima facie case of

claim indefiniteness. Fourth, the Assignee notes that claim amendments have obviated the claim rejections.

### **Copending applications**

Under the provisions of MPEP § 2001.06(b), the Examiner is hereby advised of information obtained from co-pending U.S. Patent Application(s) which may be "material to patentability" of the instant application (see *Armour & Co. v. Swift & Co.*, 466 F.2d 767, 779, 175 USPQ 70, 79 7th Cir. 1972).

A review of co-pending applications has revealed that the apparently routine allowance and issue of patents to large companies for "inventions" that do not appear to meet the requirements for allowance (i.e. novelty, written description, etc.) appears to be having a material, negative impact on the prosecution of the assignee's patent applications. In accordance with the prevailing statutes, the allowance and issue of patents to large companies for inventions that do not appear to meet the requirements for allowance should not have any impact on the prosecution of Asset Trust patent applications. In fact, the U.S.P.T.O. has a professed commitment and a legal obligation to invalidate patents that do not meet the legal requirements for patentability. Unfortunately, the U.S.P.T.O. appears to be shielding the patents issued to large companies for "inventions" that do not appear to meet the statutory requirements for allowance instead of honoring their statutory obligation to invalidate them. In particular, the Assignee has recently determined that the primary reasons it has been forced to file over twenty appeals all appear to be related to efforts to bolster patents issued to large companies for inventions that do not appear to be novel. These reasons include:

- 1) the need to traverse apparent misrepresentations that prior art that should properly be used to prevent the allowance of (or invalidate) one or more patents issued to a large company is relevant to an Asset Trust patent application. This is the single largest reason the Assignee has been forced to file appeals. For example, U.S. Patent 5,812,988 (hereinafter, Sandretto) which teaches the use of pre-defined rules in an iterative process for risk return asset valuation is being used to reject claims in co-pending U.S. Patent Application 10/097,344 for an invention that uses artificial intelligence methods to learn from the data and value elements of value without considering their risk. Of note is the fact that Sandretto was not cited during the review of almost all of the patents issued to a large company for inventions that use pre-defined rules in an iterative process for asset valuation and/or analysis.

In a similar fashion, the primary reference used to support the rejection of the claims in co-

pending application 10/012,375 is Shannon. A comparison on the key features of Shannon to the features of the invention claimed in application 10/012,375 and the features of the invention claimed in U.S. Patent 7,318,038 shows that Shannon appears to be a much closer match to the issued patent than it is to the rejected claims in the Assignee's application.

<b>Feature</b>	<b>Shannon</b>	<b>7,318,038</b>	<b>10/012,375</b>
<b>Primary function</b>	Process simulation tool that calculates resources required to complete a project based upon contents of user-defined benefit-trade matrices, design requirement priority values and a sample design.	Provides techniques, systems and apparatus for assessing risk associated with a project or a portfolio of projects.	Identifies project features that optimize the impact of the project on the value and risk of the sponsoring organization.
Calculate project cost based on historical data?	Yes	Yes	No
Calculate project risk based on historical data?	Yes	Yes	No
Calculate project profit based on historical data?	No	Yes	No
Model project impact on value and risk of sponsoring organization?	No	No	Yes
Develop a model of sponsoring organization value and risk?	No	No	Yes

2) the need to traverse apparent misrepresentations that one or more patents issued to a large company for an "invention" that does not appear to meet the requirements for patentability is relevant to an Asset Trust patent application.

3) the need to traverse rejections apparently made without explanation that inventions similar or identical to those found in patents issued to large companies represent non-statutory subject matter and/or lack utility. This is clearly the case in the instant application.

4) the apparently improper use of Official Notice. For example, in application 10/237,021 Official Notice was claimed twice even though it was cited only once. No examples were provided that supported its use in either case and there was no response to the traversal of the Official Notice. This practice also appears to have been utilized in the instant application.

5. the need to traverse rejections apparently made without evidence that methods and/or claims similar or identical to those found in patents issued to large companies are "too subjective" and/or not enabled.

6. the need to traverse rejections made for informalities. This practice also appears to have been utilized in the instant application as many claims are rejected for informalities (please note these informalities have been corrected).

The subject matter contained in the discussion above may be deemed to relate to the present application, and thus may be felt (with or without reasonable justification) to be material to the prosecution of this instant application.

☐ Copies of cited U.S. patent application(s) (specification, claims, and the drawings) or copies of the portion(s) of the application(s) which caused it(them) to be cited, including any claims directed to such portion(s) are attached hereto.

☒ Copies of the cited U.S. Patent Application(s) (specification, claims, and the drawings) and U.S. Patents are available on the U.S.P.T.O.'s Image File Wrapper. Therefore copies thereof need not be attached.

☐ The materials in the envelope are considered trade secrets and are being submitted for consideration under MPEP § 724.

The above-listed co-pending application(s) is not to be construed as prior art. By bringing the above-listed application(s) to the attention of the Examiner, the Assignee does NOT waive any confidentiality concerning the above-listed co-pending application(s) or this application. See MPEP §101. Furthermore, if said application(s) should not mature into patents, such application(s) should be preserved in secrecy under the provisions of 35 U.S.C. § 122 and 37 C.F.R. § 1.14.

### **Acknowledgement**

The Assignee previously requested: an unbiased patent application examination conducted by an Examiner with knowledge of the relevant arts who follows the law. The Office's apparent failure to provide such an examination for the instant application is taken as an acknowledgment

that no personnel with the requisite level of skill in the art and/or training in the relevant statutes and precedents are available at the present time.

#### **Statement under 37 CFR 1.111**

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

*In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.*

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reason the prior set of claims were amended was to correct clerical errors and put the application in final form for issue and allowance.

#### **Reservation of rights**

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

#### **Conclusion**

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,

Asset Trust, Inc.

/B.J. Bennett/

B.J. Bennett, President

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